

### **REMARKS**

Reconsideration is respectfully requested in view of the above amendments and the following remarks. Claims 22, 23, 26-30, and 33-36 have been canceled. New claim 37 has been added. Therefore, the pending claims in the application are 21, 24, 25, 31, 32, and 37-44.

1. **Substitution of Drawing Sheets**

Applicant herein submits substitute drawing sheets for Fig. 1, Fig. 2, Fig. 4, and Fig. 5 attached hereto as Attachment A. In Fig. 1, the "gray" areas are removed. In Fig. 2 and Fig. 4, the "gray" areas behind the characters have been removed. In Fig. 2 and Fig. 5, pointers from the reference numbers to the component has been incorporated. Also, in Fig. 5, reference number 530 for the "Logging Table" has been included, and support for this is found in the specification on page 34, line 5. The Applicant asserts that no new matter has been added, and the Applicant respectfully requests entry of the substitute drawing sheets.

2. **Objection to the Abstract of the Disclosure**

The abstract is objected to as not specifically describing the subject matter of the claims. In response, the Applicant has amended the abstract in compliance with MPEP § 608.01(b) to more specifically describe the subject matter of the invention being claimed. Therefore, withdrawal of this objection is respectfully requested.

3. **Objections to Claims**

Claims 26, 27, and 34 are objected to because of informalities. The cancellation of claims 26, 27, and 34 has rendered this objection moot.

4. Claim Rejection Under 35 U.S.C. § 112

Claims 21-36 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Specifically, the Examiner indicated that there is insufficient antecedent basis for the limitation “the electronic storage medium” in claims 21, 26, 28, and 30.

In response, the article “the” preceding the first instance of “electronic storage medium” has been amended to “an”, thereby eliminating the need for an antecedent basis with regard to the first instance of that limitation. The cancellation of claims 26, 28, and 30 has rendered the rejection moot as to those claims. Therefore, withdrawal of this rejection is respectfully requested.

5. Claim Rejection Under 35 U.S.C. § 102

Claims 21, 26, and 28-30 are rejected under 35 U.S.C. § 102(e) as being anticipated by Mages et al. (U.S. Patent No. 5,892, 825). Claims 26 and 28-30 have been canceled. Independent claim 21 has been amended to recite a method for tracking the distribution of content electronically, comprising the steps of detecting a tracking identifier when an electronic storage medium is accessed by a computer; transmitting, as a function of the tracking identifier having been detected, tracking information to a server computer; and determining, as a function of the tracking information having been transmitted to the server computer and as a function of a retailer that sold the electronic storage medium, an appropriate advertisement to transmit to the computer utilizing logic in the server computer.

Mages et al. fails to disclose, *inter alia*, determining as a function of the tracking information a retailer that sold the electronic storage medium, as indicated by the Examiner on page 5, third paragraph of the Office action mailed 11/9/02. Since Mages et al. fails to disclose at least one limitation recited in the Applicant's claimed invention, claim 21 is not anticipated by Mages et al. Therefore, withdrawal of this rejection is respectfully requested.

6. Claim Rejection Under 35 U.S.C. § 103

(a) Claims 22-25 and 27 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Mages et al. in view of Brindze et al. (U.S. Patent No. 5,822,291). Claims 22, 23, and 27 have been cancelled. Claims 24 and 25, that depend from claim 21, are pending.

Brindze et al. fails to disclose, *inter alia*, the limitation of determining, as a function of the tracking information having been transmitted to the server computer and as a function of a retailer that sold the electronic storage medium, an appropriate advertisement to transmit to the computer utilizing logic in the server computer. The Examiner asserts on page 5, fourth paragraph of the Office action that Brindze et al. teaches determining as a function of the tracking information a retailer that sold the electronic storage medium. Brindze et al., however, fails to disclose the limitation of determining, as a function of the tracking information having been transmitted to the server computer and as a function of a retailer that sold the electronic storage medium, an appropriate advertisement to transmit to the computer. Brindze et al. discloses use of vendor information only in order to enable payments to that vendor for plays of the mass storage element (22) beyond what was initially sold (col. 12, lines 4-11). Brindze et al., however, does not disclose use of vendor information to help to determine an appropriate advertisement to transmit to the computer. Moreover, there is no teaching, suggestion, or motivation, found in either Mages et al. or Brindze et al., alone or in combination with any other reference, to use vendor information, in conjunction with the tracking information, to determine an appropriate advertisement to transmit to the computer. The invention as recited in claim 21 allows specifically targeted advertising to be sent to a user's computer, based on the type of vendor that sold the electronic storage medium. For example, a customer who purchased the electronic storage medium from Blockbuster (a video renter and retailer) may not necessarily be interested in seeing advertising from Best Buy (a retailer in home appliances, automotive electronics, and the like). Targeted advertising as such helps maintain user interest in the advertising

information transmitted, thus reducing the likelihood that the user summarily deletes the advertising information being displayed on the computer.

Since Mages et al. and Brindze et al. each fail to disclose at least one common limitation recited in claim 21, it follows that the combination of both references fails to disclose the invention recited in claim 21. As such, claim 21, as well as claims 24 and 25 that depend therefrom, are patentable over Mages et al. in view of Brindze et al.

(b) Claims 31 and 32 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Mages et al. in view of Takahashi (U.S. Patent No. 5,878,020). Claims 31 and 32 depend from claim 21.

As discussed above, Mages et al. fails to disclose, *inter alia*, determining as a function of the tracking information a retailer that sold the electronic storage medium. Similarly, Takahashi also fails to disclose, *inter alia*, determining as a function of the tracking information a retailer that sold the electronic storage medium.

Since Mages et al. and Takahashi each fail to disclose at least one common limitation recited in claim 21, it follows that the combination of both references fails to disclose the invention recited in claim 21. As such, claim 21, as well as claims 31 and 32 that depend therefrom, are patentable over Mages et al. in view of Takahashi.

(c) Claims 33-36 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Mages et al. in view of Takahashi, and further in view of Brindze et al. as applied to claims 31 and 32. Since claims 33-36 have been canceled, this rejection is moot.

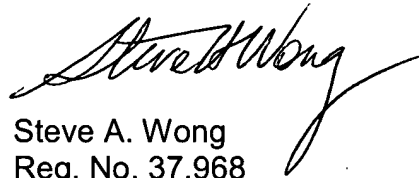
7. Conclusion

37-44

In view of the foregoing, claims 21, 24, 25, 31, 32, and ~~37~~ are believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and pass this application to issue.

The Applicant also respectfully requests a telephone interview with the Examiner, and the constructive assistance of the Examiner in the event that there are questions regarding this response or if the next action on the merits is not an allowance of all pending claims.

Respectfully submitted,  
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**Attachment: Version with Markings to Show Changes Made**

**VERSION WITH MARKINGS TO SHOW CHANGES MADE**

**In the Title:**

The Title has been amended as follows: --SYSTEM, METHOD AND ARTICLE OF MANUFACTURE FOR TRANSMISSION OF ADVERTISEMENTS BASED ON THE CONTENT OF AN ELECTRONIC STORAGE MEDIUM--

**In the Abstract:**

The Abstract of the Disclosure has been amended as follows:

--A system, method, and article of manufacture for tracking the distribution of content on an electronic storage medium is disclosed. A tracking identifier is detected when the electronic storage medium is accessed by a computer. The detected tracking identifier is transmitted to a server computer where it is determined, as a function of the tracking identifier and the retailer that sold the electronic storage medium, an appropriate advertisement to transmit to the accessing computer using logic in the server computer.--.

**In the Claims:**

Claims 22-23, 26-30, and 33-36 have been cancelled.

Claims 21 and 31 have been amended as follows:

- 1           21. (Amended) A method for tracking the distribution of content
- 2 electronically, comprising the steps of:
- 3           (a) detecting a tracking identifier when ~~the~~ an electronic storage medium is
- 4 accessed by a computer;
- 5           (b) transmitting, as a function of the tracking identifier having been
- 6 detected, tracking information to a server computer; and
- 7           (c) determining, as a function of the tracking information having been
- 8 transmitted to the server computer and as a function of a retailer that sold the

9 electronic storage medium, an appropriate advertisement to transmit to the  
10 computer utilizing logic in the server computer.

1 31. (Amended) The method of claim 21 ~~30~~, wherein the electronic storage  
2 medium tracking identifier is in a Burst Cut Area.

Claims 37-44 have been added.

1 37. (New) The method recited in claim 21, wherein said appropriate  
2 advertisement comprises at least one Uniform Resource Locator.

1 38. (New) A system for transmitting advertising based on the content of an  
2 electronic storage medium comprising:

- 3 (a) means for receiving a tracking identifier that identifies an electronic  
4 storage medium that is accessed by a computer; and  
5 (b) means for determining, as a function of the tracking information  
6 received and as a function of a retailer that sold the electronic  
7 storage medium, an appropriate advertisement to transmit to the  
8 computer.

1 39. (New) A system recited in claim 38 further comprising means for  
2 performing a table lookup to determine one or more authorized titles.

1 40. (New) A system recited in claim 38 further comprising means for  
2 writing a transaction to a database memorializing processing.

1 41. (New) A system recited in claim 38, wherein the electronic storage  
2 medium tracking identifier is in a Burst Cut Area.

1           42. (New) A system recited in claim 41, wherein a digital code is in the  
2 Burst Cut Area.

1           43. (New) A system recited in claim 38, wherein said appropriate  
2 advertisement comprises at least one Uniform Resource Locator.

1           44. (New) A system recited in claim 38, wherein said receiving means  
2 comprises a server computer.